

Remarks/Arguments

A. Claims in the Case

Claims 1-24 and 26-35 are pending. Claims 1, 21, 27, 32, and 35 have been amended. Claim 25 has been cancelled.

B. The Claims Are Not Anticipated by Dapsalmon Pursuant to 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 2, 9, 14-16, 18, 27, and 32 under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent No. 5,685,014 to Dapsalmon (hereinafter “Dapsalmon”). Applicant respectfully disagrees with these rejections.

The standard for “anticipation” is one of fairly strict identity. To anticipate a claim of a patent, a single prior source must contain all the claimed essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q.81, 91 (Fed.Cir. 1986); *In re Donahue*, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed.Cir. 1985).

Regarding Dapsalmon, the Examiner states: “the protective portion is visually distinct/different in color than the less protective portion, col. 4, lines 24-25 & col. 4 lines 38-44.”

Dapsalmon states:

Whereas fibers of the covering 4 have a color chosen to be distinct from that of the core 3. These fibers of the covering 4 mask the core so that the yarn 2, and the protective gear in general, as knitted, will have substantially the same color as the fibers of the covering 4.
(Dapsalmon, col. 4, lines 24-28)

“By providing a yarn 2 in which the fibers of the core 3 and of the covering 4 have distinct colors, and by arranging the fibers of the covering 4

such that they substantially cover the core 3, a yarn is obtained whose color is substantially the same as that of the fibers of the covering 4. The same applies to the gear knitted using this yarn 2.”
(Dapsalmon, col. 4., lines 38-44)

Dapsalmon further states:

A knitted individual protective gear... characterized in that,
the yarn (2) of high physical resistance with which the individual protective gear is knitted is a fiber core (3) surrounded by an outer fiber covering (4);

fibers of the core have a selected color;

fibers of the covering (4) have a color chosen to be distinct from that of the core (3);

cuts and/or abrasion alter the covering (4) on a permanent basis, allowing the core (3) to be seen, so that the larger the alteration, the closer the shade of the altered parts will be to the color of the core (3), in order for the gear to have an indicator of the protection performance in the gear's current state.

(Dapsalmon, abstract)

Amended claim 1 recites in part: “wherein the protective portion is of a different color than the less protective portion, and wherein the protective portion is visible to a user of the guard before use of the guard.” Amendments to claim 1 are supported by Applicant's Specification at least on page 7, line 31 through page 8, line 3.

Dapsalmon appears to describe knitted protective gear in which a fiber core is a distinct color from an outer fiber covering of the core, such that a cut and/or abrasion alters the covering to reveal the color of the core. Dapsalmon does not appear to teach or suggest at least the above-quoted features of claim 1 in combination with other features of the claim. Applicant respectfully requests removal of the rejection of claim 1 and the claims dependent thereon.

The Examiner states: “With regard to claim 18, the protective portion has a longer length than a length of the less protective portion, col. 3, lines 46-49.”

Dapsalmon states: “Such a yarn comprises a fiber core 3, surrounded by an outer fiber covering 4. Here the term ‘fiber’ applies to any yarn 2 comprising short, long or continuous

fibers or a mixture of these fibers.” (Dapsalmon, col. 3, lines 46-49) Figure 2 of Dapsalmon depicts covering 4 extending beyond core 3. Applicant submits that the protective portion of Dapsalmon does not have “a longer length than a length of the less protective portion,” as stated by the Examiner. Applicant respectfully requests removal of the rejection of claim 18.

The Examiner states: “With regard to claims 27 & 32, it is inherent that the color of the protective portion will contrast with the color of the digit.”

Amended claim 27 recites in part: “coloring the protective portion so that the protective portion contrasts with a color of the digit so that limits of protection afforded by the protective guard are visualized by a user before use of the protective guard.” Support for the amendment to claim 27 may be found at least on page 15, lines 22-24 of Applicant’s Specification. Dapsalmon does not appear to teach or suggest at least the above-quoted features of claim 27 in combination with other features of the claim. Applicant respectfully requests removal of the rejection of claim 27.

Amended claim 32 recites in part: “using color of a protective portion of the protective guard to guide positioning of the protective portion over part of a dorsal portion of the digit, wherein the protective portion comprises a color that is visibly distinct from a color of the digit”. Support for the amendment to claim 32 may be found at least on page 22, lines 5-8 of Applicant’s Specification. Dapsalmon appears to describe protective gear in which a color of the protective core is covered by an outer fiber covering. Dapsalmon does not appear to teach or suggest at least the above-quoted features of claim 32 in combination with other features of the claim. Applicant respectfully requests removal of the rejection of claim 32.

C. The Claims Are Not Anticipated by Machida Pursuant to 35 U.S.C. § 102(b)

The Examiner rejected claims 27 and 28 under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent No. 5,133,087 to Machida et al. (hereinafter “Machida”). Applicant respectfully disagrees with these rejections.

The Examiner states: “Machida et al. (hereinafter Machida) discloses a protective guard/gloves which covers a portion of the digit, col. 1, lines 10-12, that is made of a less protective portion being bonded/laminated together with a protective portion which changes color upon contact, col. 1, line 60 – col. 4, line 9. Further, it is inherent that the color of the guard contrast with the color of the digit.”

Machida states:

Preferably, the outer layer should have a transparency so that a color change of an underlying color indicator layer can be visually ascertained and, in addition, have a resistance to an acid and an alkali.
(Machida, col. 1, lines 63-66)

Although no particular limitation is applied to the material for the outer layer, since this layer is subjected to a direct contact with an acid or an alkali, it is advantageous to make use of such materials as having a remarkable resistance to acid and alkali.
(Machida, col. 2, lines 3-7)

Further, for example where the safety in use is particularly required depending on the utility of the laminate, it may be devised to provide next to or inner to the color indicator layer a further layer comprising a rubber or resin having a resistivity to acid and alkali. In this case, it is feasible to effectively avoid a danger even if the color indicator is wholly destroyed.
(Machida, col. 2, lines 40-46)

Applicant submits that Machida does not appear to teach or suggest “a protective guard/gloves... that is made of a less protective portion being bonded/laminated together with a protective portion which changes color upon contact....” as stated by the Examiner. Machida appears to describe a transparent, protective outer layer. Applicant further submits that the color indicator layer of Machida does not appear to be “a protective portion,” as stated by the Examiner.

Amended claim 27 recites in part: “coloring the protective portion so that the protective

portion contrasts with a color of the digit so that limits of protection afforded by the protective guard are visualized by a user before use of the protective guard.” The amendment to claim 27 is supported by Applicant’s Specification at least on page 15, lines 21-24. Machida appears to teach a color indicator layer that changes color upon penetration of an outer layer and following contact of the color indicator layer with an acid or an alkali. Machida does not appear to teach or suggest at least the above-quoted features of claim 27 in combination with other features of the claim. Applicant respectfully requests removal of the rejections of claim 27 and claim 28.

D. The Claims Are Not Unpatentable Over Dapsalmon Pursuant to 35 U.S.C. § 103(a)

The Examiner rejected claims 4-7 and 11-13 under U.S.C. 103(a) as being unpatentable over Dapsalmon. Applicant respectfully disagrees with these rejections.

To reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03. Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Amended claim 1 recites in part: “wherein the protective portion is of a different color than the less protective portion, and wherein the protective portion is visible to a user of the guard before use of the guard.” Applicant submits that Dapsalmon does not appear to teach or suggest the features of claims 4-7 and 11-13 in combination with the features of claim 1. Applicant respectfully requests removal of the rejections of claims 4-7 and 11-13.

E. The Claims Are Not Unpatentable Over Dapsalmon In View Of McCrane Pursuant to 35 U.S.C. § 103(a)

The Examiner rejected claims 3, 8, 21-22, 24, 26, and 33 under 35 U.S.C. 103(a) as being unpatentable over Dapsalmon in view of U.S. Patent No. 4,958,384 to McCrane (hereinafter "McCrane"). Applicant respectfully disagrees with these rejections.

The Examiner states: "Dapsalmon discloses the invention as set forth above except for showing the body being shaped with an open end to allow a portion of the digit pad therethrough and a portion of a medial joint being uncovered."

Amended claim 1 recites in part: "wherein the protective portion is of a different color than the less protective portion, and wherein the protective portion is visible to a user of the guard before use of the guard." The cited art does not appear to teach or suggest at least the above-quoted features of claim 1, in combination with other features of the claim. Applicant requests removal of the rejections of claims 3 and 8 which are dependent on claim 1.

Claim 21 has been amended to include features of objected to claim 25. Amended claim 21 recites in part: "a body having an opening in an end configured to allow a portion of a pad of the digit to remain uncovered by the guard during use, wherein the end comprises a lip configured to provide an indicator of an insertion depth of the body on the digit". Applicant submits that the cited art does not appear to teach or suggest at least the above-quoted features of claim 21 in combination with other features of the claim. Applicant respectfully requests removal of the rejections of claim 21 and claims 22, 24, and 26 dependent thereon.

Amended claim 32 recites in part: "using color of a protective portion of the protective guard to guide positioning of the protective portion over part of a dorsal portion of the digit, wherein the protective portion comprises a color that is visibly distinct from a color of the digit." Applicant submits that the cited art does not appear to teach or suggest the features of claim 33 in

combination with at least the above-mentioned features of independent claim 32. Applicant respectfully requests removal of the rejection of claim 33.

F. The Claims Are Not Unpatentable Over Machida In View Of McCrane Pursuant to 35 U.S.C. § 103(a)

The Examiner rejected claims 29 and 30 under U.S.C. 103(a) as being unpatentable over Machida in view of McCrane. Applicant respectfully disagrees with these rejections.

The Examiner states: “Machida discloses the invention as set forth above except for showing the body being shaped with an open end to allow a portion of the digit pad therethrough and a portion of a medial joint being uncovered.”

Amended independent claim 27 recites in part: “coloring the protective portion so that the protective portion contrasts with a color of the digit so that limits of protection afforded by the protective guard are visualized by a user before use of the protective guard.” The cited art does not appear to teach at least the above-quoted features of claim 27 in combination with other features of the claim. Applicant respectfully requests removal of the rejections of claims 29 and 30, dependent upon claim 27.

G. The Claims Are Not Unpatentable Over Sorrels In View Of Dapsalmon Pursuant to 35 U.S.C. § 103(a)

The Examiner rejected claims 1-9, 12-24, 27-30, and 32-35 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,450,626 to Sorrels (hereinafter “Sorrels”) in view of Dapsalmon. Applicant respectfully disagrees with these rejections.

Amended claim 1 recites in part: “wherein the protective portion is of a different color than the less protective portion, and wherein the color of the protective portion is visible to a user of the guard before use of the guard.” Applicant submits that the cited art does not appear to

teach or suggest at least the above-quoted features of claim 1 in combination with other features of the claim. Applicant respectfully requests removal of the rejections of claim 1 and claims 2-9 and 12-20 dependent thereon.

Claim 21 has been amended to include features of objected to claim 25. Applicant submits that the cited art does not appear to teach or suggest at least the features of amended claim 21. Applicant respectfully requests removal of the rejections of claim 21 and claims 22-24 dependent thereon.

Amended claim 27 recites in part: “coloring the protective portion so that the protective portion contrasts with a color of the digits so that limits of protection afforded by the protective guard are visualized by a user before use of the protective guard.” Applicant submits that the cited art does not appear to teach or suggest at least the above-quoted features of claim 27 in combination with other features of the claim. Applicant respectfully requests removal of the rejections of claim 27 and claims 28-30 dependent thereon.

Amended claim 32 recites in part: “using color of a protective portion of the protective guard to guide positioning of the protective portion over part of a dorsal portion of the digit, wherein the protective portion comprises a color that is visibly distinct from a color of the digit.” Applicant submits that the cited art does not appear to teach or suggest at least the above-quoted features of claim 32 in combination with other features of the claim. Applicant respectfully requests removal of the rejections of claim 32 and claims 33 and 34 dependent thereon.

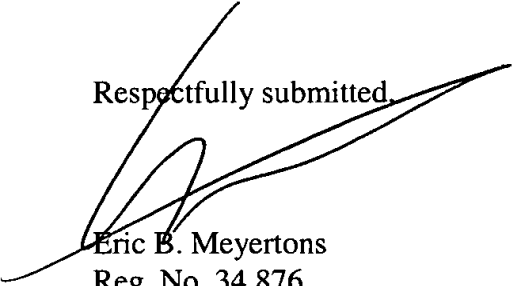
Amended claim 35 recites in part: “wherein a color difference between the protective portion and the less protective portion allows a user to visually confirm positioning of the protective portion of the guard relative to the digit.” Applicant submits that the cited art does not appear to teach or suggest at least the above-quoted features of claim 35 in combination with other features of the claim. Applicant respectfully requests removal of the rejection of claim 35.

H. Additional Comments

Applicant submits that all claims are in condition for allowance. Favorable consideration is respectfully requested.

Applicant believes that no fees are due with the filing of this response. If an extension of time is needed, Applicant requests the appropriate extension of time. If any fees are due, please appropriately charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5588-00101/EBM.

Respectfully submitted,



Eric B. Meyertons
Reg. No. 34,876

Attorney for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

Date: March 2, 2004